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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,603	07/12/2001	Jennifer L. Hillman	PF-0211-2 DIV	4380

7590 05/30/2003

INCYTE GENOMICS, INC.  
PATENT DEPARTMENT  
3160 Porter Drive  
Palo Alto, CA 94304

EXAMINER

NAVARRO, ALBERT MARK

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/904,603

Applicant(s)

Hillman et al

Examiner

Mark Navarro

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15, 27, 28, 30, 43, and 44 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-15, 27, 28, 30, 43, and 44 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-2, drawn to a polypeptide, classified in class 530, subclass 350.
  - II. Claims 3-7, 9, and 11-12, drawn to DNA, classified in class 536, subclass 23.1.
  - III. Claim 8, drawn to transgenic organisms, classified in class 800, subclass 2.
  - IV. Claims 10 and 30, drawn to antibodies, classified in class 530, subclass 387.1.
  - V. Claims 13-15, drawn to methods of detecting DNA, classified in class 435, subclass 6.
  - VI. Claim 27, drawn to methods for screening a compound for effectiveness in altering expression, classified in class 435, subclass 4.
  - VII. Claim 28, drawn to methods for assessing toxicity of a test compound, classified in class 435, subclass 4.
  - VIII. Claim 43, drawn to methods of detecting a polypeptide, classified in class 435, subclass 7.1.
  - IX. Claim 44, drawn to methods of purifying a polypeptide, classified in class 530, subclass 412.
2. The inventions are distinct, each from the other because of the following reasons:

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Invention I drawn to a polypeptide and Invention II drawn to a DNA molecule are distinct since they are products with different structure and biological properties. The polypeptide is made of amino acids whereas the claimed nucleic acid is made of nucleotides. Further methods known in the art used to make the polypeptide require different reagents and parameters from the methods of making DNA encoding the protein and the method of making the polypeptide does not require the DNA. For instance, the protein can be made by Merrifield chemical synthesis or affinity chromatography.

Invention III, drawn to a transgenic organism, is distinct from Inventions I-II and IV-IX, since it is an altered form of life.

Invention IV, drawn to antibodies, is distinct from Inventions I-III and V-IX, since it displays an inherent affinity, avidity and specificity for a given epitope.

Invention V, drawn to methods of detecting DNA, is distinct from Inventions I-IV and VI-IX, since it requires additional biological reagents and parameters for detecting the DNA molecule.

Inventions VI-IX, drawn to methods of detecting DNA, assessing toxicity, detecting polypeptides and purifying polypeptides, respectively, are distinct from Inventions I-V and each other, since each requires additional biological reagents and parameters and involve the detection or identification of different properties of a biological molecule.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their separate classification and their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro whose telephone number is (703) 306-3225.

  
Mark Navarro

Primary Examiner

May 27, 2003